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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,217	10/23/2003	Peter J. Ulitz	109770.0018	8227
37287	7590	11/01/2007		
ROETZEL & ANDRESS			EXAMINER	
1375 EAST 9TH STREET			CULBRETH, ERIC D	
CLEVELAND, OH 44114				
			ART UNIT	PAPER NUMBER
			3616	
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			11/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/692,217	ULINTZ, PETER J.
	<b>Examiner</b>	<b>Art Unit</b>
	Eric Culbreth	3616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 25 July 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 23 October 2003 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

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### **DETAILED ACTION**

1. Applicant's appeal brief regarding the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

#### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the sleeve located entirely within the outer jacket (claim 27) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: There is no support in the specification for claim 27.

***Claim Objections***

4. Claims 9, 21 and 26 are objected to because of the following informalities:  
“the surface area” should be “a surface area” (claim 9, line 1).  
“and outer jacket” should be “an outer jacket” (claim 21, line 2).  
“is” should be “are” (claim 26, line 3). Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.  
6. Claims 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 11, it is unclear if the applicant is intending to claim a configuration in which a lower end of the inner jacket (referred to as “second end” in the

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specification) is engaged at a lower end of the outer jacket (referred to as a "second end" in the specification), or if this portion of the claim is a simple grammatical mistake. The drawings and the specification set forth an inner jacket that is engaged at an upper end (referred to as a "first end" in the specification) with a lower end of an outer jacket (referred to as a "second end" in the specification).

(Incidentally, it is noted that the Appeal Brief filed 7/25/07 did not address the rejection under 35 USC 112; a proper Brief should address all rejections. In the future, such an omission may result in a holding of a defective brief).

#### ***Claim Rejections - 35 USC § 102***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. Claims 1-3, 5-13, 15-24, 26 and 28-30 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Milton et al US3703105, of record.

Milton et al discloses a telescoping steering column assembly 10, 12 comprising outer jacket 52 (outer relative to inner jacket 50 as broadly recited) with a first end (i.e., left end in Figure 3) and a second end (i.e., right end in Figure 3), an inner jacket 50 with a first end (i.e., left end in Figure 3) and a second end (i.e., right end in Figure 3), the first end of the inner jacket dimensioned to be received telescopically within the second end of the outer jacket (columns 6-7; Figures 2,3,5,6), and sleeve 54 having a wall (in Figure 4, portion of 54 that does not protrude) and positioned inside of the outer jacket at the second end of the outer jacket (best seen in Figure 3), the wall being

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spaced from the inner jacket and outer jacket (via protrusions; best seen in Figure 4).

The first end of the inner jacket is positioned within the sleeve inside the outer jacket (best seen in Figure 3), and the assembly is configured for telescoping movement between the outer jacket and the inner jacket with an outer surface of the inner jacket in contact with the inner surface of the sleeve and an inner surface of the outer jacket in contact with an outer surface of the sleeve (best explained in columns 6-7; best seen in Figures 2, 3, 5, 6). The inner surface of the sleeve which contacts the outer surface of the inner jacket is located on at least one internal rib (for example, including ribs 86, 92), which protrudes from the wall of the sleeve and is aligned with a longitudinal axis of the sleeve (best seen in Figure 4). The outer surface of the sleeve which contacts the inner surface of the outer jacket is located on at least one external rib (for example, ribs 88, 92), which protrudes from the wall of the sleeve and is aligned with a longitudinal axis of the sleeve (best seen in Figure 4) (claims 1 and 11).

Internal rib 92 is offset from external rib 92 (claims 2, 12 and 23).

As broadly recited, biasing rib 92 on the exterior of the sleeve wall is radially axially aligned with an internal rib 86 of the sleeve (best seen in Figure 4)(claims 3, 13 and 24).

A width dimension (surface area) of an internal rib 86 of the sleeve is greater than a width dimension (surface area) of an external rib 92 of the sleeve (best seen in Figure 4)(claims 5, 9, 15 and 28).

A combined thickness dimension of the wall of the sleeve, at least one internal rib, and at least one external rib is at least equal to a distance between the outer

surface of the inner jacket and the inner surface of the outer jacket (best seen in Figure 4) (claims 6 and 16).

The internal ribs 86, 92 protrude from an interior of the sleeve wall at radially spaced locations (best seen in Figure 4) (claim 7).

External ribs 88, 92 protrude from an exterior of the sleeve wall at radially spaced locations (best seen in Figure 4) and are radially offset from the radially spaced internal ribs (specifically 86 and 88 are radially offset from each other, and ribs 92 and 92 are radially offset from each other) (claim 8).

The wall of the sleeve is flexible between the outer surface of the inner jacket and the inner surface of the outer jacket (column 5, line 60 – column 6, line 7) (claims 10 and 18).

A segment of the sleeve (flange 94 at least) extends past the distal end (second end) of the outer jacket as best understood (Figure 3)(claim 17).

The outer jacket is fixed, the sleeve is secured to the outer jacket, and the inner jacket is able to telescope relative to the outer jacket and sleeve; alternatively, the inner jacket is fixed, the sleeve is secured to the outer jacket, and the outer jacket and sleeve are able to telescope relative to the inner jacket (column 6, line 55 – column 7, line 15) (claims 19-20 and 22).

As seen in Figure 4, a wall of the sleeve is spaced from the inner jacket and the outer jacket (claim 21) by at least two internal and two external ribs (claim 30).

The sleeve is made of a material which is relatively more flexible than a material from which the inner jacket and outer jacket are made (for example, the inner and outer

jackets are made of metal, and the sleeve is made of flexible plastic or an elastic)(claim 26).

A thickness dimension of the wall of the sleeve is greater than a thickness dimension of the internal and external ribs of the sleeve (i.e., with respect to the thickness dimension of the internal and external ribs 92) (claim 29).

Noting applicant's remarks in the appeal brief, incidentally, that Milton et al is concerned with locking the jackets, applicant's telescoping structure is also concerned with jackets that are eventually locked (page 1, lines 17-19 where the invention is to be used on assemblies that are fixed or locked; page 1, line 30 – page 2, line 2 and page 2, lines 17-18 where the invention is to be used on steering columns that are locked until collapsed in a crash just like Milton et al).

***Claim Rejections - 35 USC § 103***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
10. Claims 4, 14, and 25 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Milton et al in view of Barton et al US006389923B1.

Milton et al does not disclose the use of a bonding agent to bond the sleeve and outer jacket. Barton et al teach a telescoping steering column assembly comprising an outer steering column member 1, an inner steering column member 2 and a sleeve 3 located between the steering column members. A bonding agent (for example, an adhesive) is used between the sleeve and the outer steering column member (column

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2, lines 10-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Milton et al to include a bonding agent as claimed in view of the teachings of Barton et al so as to better retain the sleeve securely within the outer tube (Barton et al, column 2, lines 12-18). In the combination the injected adhesive would flow between the external ribs.

11. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milton et al in view of British Patent 2,205,149 (newly cited).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Milton et al to include the sleeve being entirely within the outer jacket in view of British '149, where bushing or sleeve 3 is secured entirely within outer jacket 1, in order to secure the bushing or sleeve using alternative equivalent structure in the art to Milton et al's flange 94 outside the outer jacket, as the substitution of securing structure would yield predictable results.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Culbreth whose telephone number is 571/272-6668. The examiner can normally be reached on Monday-Thursday, 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on 571/272-6669. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300:

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric Culbreth  
Primary Examiner  
Art Unit 3616

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